

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YASUO GOTO

Appeal No. 97-4084
Application 08/330,672¹

ON BRIEF

Before COHEN, PATE and CRAWFORD, Administrative Patent Judges.
PATE, Administrative Patent Judge.

¹ Application for patent filed October 28, 1994.

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DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 3, 12, 15 and 17 through 19, and the examiner's refusal to allow claims 4, 10, 14 and 16 as amended after final rejection. Claims 6 through 9, 11 and 20 through 22 stand withdrawn from consideration as subject to a restriction requirement. Claim 13 has been indicated as directed to allowable subject matter. It stands objected to. These are all the claims remaining in the application.

The claimed invention is directed to a hollow elongated tubular member for use in connecting two structural elements at a joint. The hollow elongated member has an interior passage which receives adhesive injected therein. At the distal end of the passage, a radial passage is configured to allow the adhesive to escape from the tubular member and fill the bore hole that the elongated tubular member is placed in. A further understanding of the subject matter on appeal can be garnered from the appealed claims which are appended to appellant's Appeal Brief.

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The references of record relied upon by the examiner
as evidence of obviousness are:

Titus et al. (Titus) 1985	4,516,608	May 14,
Lancelot 1995	5,383,740	Jan. 24,

THE REJECTION

Claims 1 through 4, 10, 12 and 14 through 19 stand
rejected under 35 U.S.C. § 103 as unpatentable over Lancelot
in view of Titus. According to the examiner, Lancelot shows
the features of the claimed subject matter except Lancelot is
not made of a laminated structure of two or more materials.
The examiner is further of the opinion that Titus teaches the
use of a laminated structure for increasing the strength of
the laminated article. Therefore, the examiner is of the
opinion that

[i]t would have been obvious to a person
having ordinary skill in the art at the
time of appellant's invention to modify the
tubular member to have a laminated struc-
ture in view of Titus et al. in order to
provide a means of increasing the compres-
sive strength of the tubular member so as
to prevent buckling of the tubular member

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in the embedded concrete (Examiner's Answer, page 5).

OPINION

We have carefully reviewed the prior art in light of the arguments of the appellant and the examiner. As a result of this review, we have reached the determination that the applied prior art does not establish a prima facie case of obviousness with respect to the claims on appeal. Therefore, the obviousness rejection of the claims on appeal will be reversed.

Before we begin our obviousness analysis, we raise the issue of claim construction. We construe the claim limitation of "two or more materials" consistent with the specification as calling for two or more differing materials. See, for example, specification at page 11, lines 3-10.²

² Given our construction of the independent claim as calling for two or more differing materials, we have construed

While we are in agreement with the examiner as to many of his findings of fact with respect to the Lancelot reference, we find ourselves in agreement with the appellant that there is no motivation in the applied prior art or a convincing line of reasoning from the examiner that would have suggested the combination of Lancelot and the Titus disclosure. The examiner can point to no express or implied teaching in the prior art, and the examiner's reasoning with respect to compressive strength found on page 5 of the Examiner's Answer is not convincing. It is clear to us that the connector disclosed in Lancelot is designed to carry tensile forces from one concrete reinforcement bar to the other. The teaching of Titus of improving the

compressive strength of an oil well sucker rod or an oil well casing simply does not transfer over to the problem that concerns Lancelot. Having found that the examiner's rejection

claim 10 as calling for a laminated structure comprising a first layer made from a member of a group consisting of metal, plastic, ceramic, and wood, and a second layer made from a member of a group consisting of metal, plastic, ceramic and wood differing in composition from the first layer.

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lacks the requisite motivation or suggestion for combining prior art references, we are constrained to reverse the obviousness rejection on appeal.

SUMMARY

The rejection of claims 1 through 4, 10, 12 and 14 through 19 under 35 U.S.C. § 103 is reversed.

REVERSED

	IRWIN CHARLES COHEN)	
	Administrative Patent Judge)	
)	
)	
)	BOARD OF
PATENT)	
	WILLIAM F. PATE, III)	APPEALS AND
	Administrative Patent Judge)	INTERFER-
ENCES)	
)	
)	
	MURRIEL E. CRAWFORD)	
	Administrative Patent Judge)	

WFP:psb

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Lane Sitken & McCann
Watergate Office Building
Suite 600
2600 Virginia Avenue, N.W.
Washington, D.C. 20037